



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,157	01/18/2002	Sang Bum Kim	LT-0011	3882

34610 7590 04/07/2006

FLESHNER & KIM, LLP
P.O. BOX 221200
CHANTILLY, VA 20153

EXAMINER

NELSON, FREDA ANN

ART UNIT PAPER NUMBER

3639

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/050,157	Applicant(s) KIM ET AL.	
	Examiner Freda A. Nelson	Art Unit 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 19-46 is/are pending in the application.
- 4a) Of the above claim(s) 33-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment received on January 12, 2006 is acknowledged and entered. Claims 1 and 19 have been amended. Claims 15-18 have been canceled. Claims 26-46 have been added. Claims 1-14 and 19-46 are currently pending.

Election/Restrictions

1. Newly submitted claims 33-46 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Invention II, Claims 33-46, drawn to a method of advertising and conducting electronic commercial transactions through a commercial network, is classified in class 705, subclass 10; and the invention originally claimed (Invention I) which includes claims 1-14, and 19-24, are drawn to a method for conducting electronic commercial transactions through a commercial network, is classified in class 705, subclass 26.

In the instant case the different inventions, have different modes of operations functions.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 33-46 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Amendment and Arguments

Applicant's arguments with respect to claims 1-14 and 19-32 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 25-26, 28, 30, and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As for claims 25-26, the examiner is unable to locate determine where in the specification that is stated that a subscription is priced independently from the price of the first content".

As for claims 28, 30, and 32, the examiner is unable to locate or determine where in the specification that is stated a subscription requires a fee or does not require a fee.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3639

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites the limitation "the front, middle, and rear" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 19-20 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Kontogouris (US PG Pub. 2002/0082910).

As for claims 19-20, Kontogouris discloses a method of conducting electronic commercial transactions through a communication network, comprising:

- (a) selecting a first content having a first price to buy from a website accessed through the communication network (paragraph [0054]);
- (b) selecting at least one second content (paragraph [0066]);
- (c) presenting the selected second content to a user and asking a question about the presented second content (paragraph [0026]);
- (d) receiving a reply to the question from the user and determining whether the user has viewed the presented second content, based on the information contained in the received reply (Paragraph [0026]); and
- (e) determining a second price of the first content based on the first price of the first content and the number of second contents selected (FIG. 9).

As for claim 26, Kontogouris discloses the method of claim 19, wherein a subscription for accessing the website is priced independently from the price of the first content (paragraph [0017]) .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7, 10, 12-14, 21-25, and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kontogouris (US PG Pub. 2002/0082910) in view of Miyashita (US PG Pub. 2001/0014876).

As for claims 1-2, 5, and 13, Kontogouris discloses a method of conducting electronic commercial transactions through a communication network, comprising:

- (a) selecting a first content to buy from a website accessed through the communication network (paragraph [0054]);
- (b) selecting at least one second content having an effect of information conveyance; and
- (d) determining a price of the third content based on the first and the second content (FIG. 9).

Kontogouris does not disclose combining the first and second content to form a third content. Miyashita discloses that the system is constructed with the assumption that a general consumer views and/or listens to an advertisement attached to desired music/video content when he/she views and/or listens to the music/video content, therefore, it is undesirable to allow separation of the advertising content from the music/video content or to allow the consumer to skip the advertisement during playback of the music/video content (paragraph [0071]). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Kontogouris to include the feature of Miyashita in order to provide a technique to prevent separation or skipping of the advertising content (Miyashita; paragraph 0071).

As for claim 3, Kontogouris discloses the method of claim 1, wherein step (c) adds the second content to at least one of the front, middle, and rear of the first content (paragraph [0030]).

Art Unit: 3639

As for claim 4, Kontogouris discloses the method of claim 3, wherein each second content is converted to the format of the first content, before the combination (paragraph [0064]).

As for claim 6, Kontogouris discloses the method of claim 1, wherein the price of the third content is determined based on the number of second contents combined with the first content or each value of the second content (FIG. 9)

As for claim 7, Kontogouris discloses the method of claim 1, wherein each second content includes a list of other contents to be sold or address information of other servers providing on-line sale services (paragraph [0029]).

As for claim 10, Kontogouris discloses the method of claim 1, wherein the third content is transmitted on-line through the communications network (paragraphs [0052], [0054]; FIG. 4).

As for claims 12 and 23-24, Kontogouris discloses the method wherein the second content is inserted in a prescribed field, defined in the first content, without any data conversion (paragraphs [0025], [0051], [0064]) {conventional definition of "banner advertisement" refers to advertisements that appear as a box on a web page display screen, that may contain text, images, animation, sound, video, and/or other effects, and that includes hyperlinks to the advertiser's website. Kontogouris further discloses that those skilled in the art will appreciate that the term "banner advertisement" as used herein is not intended to be limited to advertisements that include hyperlinks to the advertiser's website, or to advertising on the Internet that may include a variety of interactive features, and that may appear in connection with any electronic medium or network, including wireless and digital television media or networks, that permits interactivity between the user's computing or communications device and remote service or content provider}.

As for claims 14 and 21-22, Kontogouris does not disclose the method, wherein the first and second contents are combined such that a playback of the first content cannot be obtained without the playback of the second content. Miyashita discloses that the system is constructed with the assumption that a general consumer views and/or listens to an advertisement attached to desired music/video content when he/she views and/or listens to the music/video content, therefore, it is undesirable to allow separation of the advertising content from the music/video content or to allow the consumer to skip the advertisement during playback of the music/video content (paragraph 0071). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Kontogouris to include the feature of Miyashita in order to provide a technique to prevent separation or skipping of the advertising content (Miyashita; paragraph 0071).

Art Unit: 3639

As for claim 25, Kontogouris discloses the method of claim 1, wherein a subscription for accessing the website is priced independently from the price of the first content (paragraph [0017]).

As for claim 27, Kontogouris discloses the method of claim 1, wherein subscription to the website is obtained by obtaining a username and password (paragraphs [0058]-[0059]).

As for claim 28, Kontogouris discloses the method of claim 27, wherein the subscription to the website does not require a fee (paragraph [0017]).

As for claim 29, Kontogouris discloses the method of claim 21, wherein subscription to the website is obtained by obtaining a username and password (paragraphs [0058]-[0059]).

As for claim 30, Kontogouris discloses the method of claim 21, wherein the subscription to the website does not require a fee (paragraph [0017]).

As for claim 31, Kontogouris discloses the method of claim 25, wherein subscription to the website is obtained by obtaining a username and password (paragraphs [0058]-[0059]).

As for claim 32, Kontogouris discloses the method of claim 25, wherein the subscription to the website does not require a fee (paragraph [0017]).

6. Claims 8-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kontogouris (US PG Pub. 2002/0082910) in view of Stern (US PG Pub. 2001/0052001).

As for claims 8-9, Kontogouris does not disclose that the third content is stored in a recording medium to be delivered to a buyer. Kontogouris does not further disclose that the recording medium is one of a CD, a DVD, a FDD, a HDD, and a memory. Stern discloses that that a new digital content distribution network is presented, providing commercial sales outlets of a commercial entity expanded bandwidth for delivery of video, audio, graphics, text, data, and other types of information streams within (and also, optionally, outside of) these commercial sales outlets (paragraph 0019). Stern further discloses that content is preferably procured by the entity operating a network management center 110 (NMC 110) via traditional recorded media (tapes, CD's, videos, and the like) wherein content provided to NMC 110 is compiled into a form suitable for distribution to and display at the commercial sales outlets being supplied (paragraph 0027). Therefore, it would have been obvious to one of ordinary skill in the art at the

Art Unit: 3639

time the invention was made to modify the invention of Kontogouris to include the feature of Stern in order to promote electronic distribution.

As for claim 11, Kontogouris does not disclose that the third content is formatted as MPEG data. Stern discloses that DDS 100 is a system employing a combination of software and hardware that provides cataloging, distribution, presentation, and usage tracking of music recordings, home video, product demonstrations, advertising content, and other such content, along with entertainment content, news, and similar consumer informational content in an in-store setting wherein this content includes content presented in MPEG1 and MPEG2 video and audio stream format, although the present system should not be limited to using only those formats (paragraph 0021). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Kontogouris to include the feature of Stern in order to provide a the user a variety of content to view.

Conclusion

7. The examiner has cited prior art of interest, for example:

1) Logan et al. (US Patent Number 5,721, 827), which disclose a system for electrically distributing personalized information.


2) Deaton et al. (US Patent Number 6,611,811), which disclose a method and system for accumulating marginal discounts and applying an associated incentive upon achieving threshold.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FAN 03/30/2006



JOHN W. HAYES
SUPERVISORY PATENT EXAMINER